09/08/03

AF/3711

Atty. Docket No. 43108.830003.000
Serial No. 10/014,297
Express Mail No. EV269463136US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of	
OISTER et al.	
	Group Art Unit: 3711
Serial No. 10/014,297	
	Examiner: Nguyen, K.
Filed: December 11, 2001	
For: GAME BALL WITH CLOCK	

APPEAL BRIEF TRANSMITTAL

Mail Stop: APPEAL BRIEFS - PATENT
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Transmitted herewith for filing is an APPEAL BRIEF, in triplicate, for the above-identified application. Enclosed is a check in the amount of $160.00 for filing of this Brief.

The Commissioner is hereby authorized to charge payment of any discrepancies in fees associated with this communication, or credit any overpayment, to Deposit Account No. 08-2623. A duplicate copy of this transmittal is enclosed.

Signed this 5 day of September 2003.

Respectfully submitted,

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Sir:

This is an appeal from the decision of the Examiner mailed on May 7, 2003, finally rejecting claims 1-21 of the above-identified patent application.

REAL PARTY IN INTEREST

The real party in interest in this appeal is Classic Sport Companies, Inc. as evidenced by an Assignment filed at Reel 012655, Frame 0853.

RELATED APPEALS AND INTERFERENCES

Neither Appellants, Appellants' legal representative, nor Appellants' assignee know of appeals or interferences that will directly affect, or be directly affected by, or have a bearing on the Board's decision in the present appeal.

STATUS OF CLAIMS

Claims 1-21 remain in this application.

This appeal is taken from the final rejection of claims 1-21.

No claims are allowed.

STATUS OF AMENDMENTS

A Request for Reconsideration After Final Office Action Under 37 C.F.R. § 1.116 was filed on May 16, 2003, in response to the May 7, 2003 Final Office Action. The Examiner did not enter the Request for Reconsideration because it requested that the Examiner reconsider the rejection, but no amendment has been filed subsequent to the final rejection mailed on May 7, 2003. After consideration of the request, the Examiner maintained the rejections in the May 7, 2003 Final Office Action.

SUMMARY OF THE INVENTION

The present invention relates to a game ball having a clock. More particularly, the present invention relates to a sports ball, such as a basketball 10 or a football 20, having a timer 12 (22) and a sound generator 16 (26). The timer 12 (22) counts a time period, such as a shot clock time for basketball, and at least at the end of the time period, the sound generator 16 (26) produces a sound indicating the end of the period.

As indicated by the specification, timer 12 (22) is preset to count particular time periods. For example, timer 12 may count seconds until a shot clock expires. (See for example, specification at page 4, lines 92-93).

ISSUES

The issues present by the present appeal are:

(1) Are claims 1-10 and 16-21 unpatentable under 35 U.S.C. § 103(a) as obvious over U.S. Patent 5,912,864 ("Maurer") in view of U.S. Patent 5,810,685 ("Willner et al.")?

(2) Are claims 11-15 unpatentable under 35 U.S.C. § 103(a) as obvious over Maurer in view of Willner et al. in further view of U.S. Patent No. 5,468,000 ("Bennett")?

GROUPING OF CLAIMS

The claims on appeal do not stand or fall together.

SUMMARY OF THE EXAMINER'S FINAL REJECTION

The Examiner finally rejected claims 1-21 in a May 7, 2003 Final Office Action.

GROUP I

The Examiner rejected claims 1-10 and 16-21 under 35 U.S.C. § 103(a) as being unpatentable over Maurer in view of Willner et al.

In particular, the Examiner is of the opinion that Maurer discloses all of the limitations except "Maurer failed to teach a sound generator integrated with the ball for producing at least one sound at the end of the time period." The Examiner claims that Willner et al. discloses a sound generator and that it would have been obvious to combine the teachings of Maurer and Willner et al. to produce the claimed invention.

GROUP II

The Examiner rejected claims 11-15 under 35 U.S.C. § 103(a) as being unpatentable over Maurer in view of Willner et al. in further view of Bennett. In particular, the Examiner applied Maurer and Willner et al. as applied to group 1, above, but admitted that neither Maurer nor Willner et al. disclosed "a proximity controller." Because Bennett disclosed a proximity detector, the Examiner is of the opinion that the present invention would have been obvious in view of the references.

SUMMARY OF THE REFERENCES

Background

Footballs, basketballs, and other sport balls have been in existence for some time. To simulate actual game conditions during sandlot, recess, or pickup games, kids typically mimic game time periods. For example, to simulate blocking and rushing in football, kids typically count off a time period. For basketball, a non-playing substitute attempts to estimate or time the shot clock.

Frequently, differences in counting style or estimation results in arguments. One player may, for example, count 5 Mississippi quicker than another player leading to a perceived advantage. Thus, it was desirous to develop a game ball that counted these time periods.

Maurer relates to a game ball with a time of flight measurement device. In particular, the Maurer reference discloses a circuit mountable in a ball to measure the time of flight of a ball. A force detector 12 senses acceleration of a ball 10 and causes a measurement and control circuit 18 to being counting time at the beginning of flight. At the end of the flight, force detector 12 senses deceleration and causes measurement and control circuit 18 to stop counting time. The time counted from start to stop is displayed on elapse time display counter 20. The Maurer device counts the time it takes an object to travel a trajectory, regardless of distance, velocity, or force.

Willner et al. relates to a game ball capable of producing a sound. In particular, an impact sensor 14, such as an acceleration sensor, senses the acceleration of the game ball and causes sound generator 18 to emit a sound when acceleration is detected. Thus, the Willner et al. device generates a sound

when force is applied to the ball. Such force could include a striking of the ball, acceleration of the ball, or the like.

Bennett relates to a location detector mountable on an arrow. In particular, a receiver 12 is mounted on an arrow shaft. The receiver 12 is responsive to a transmitter 20, such that when the receiver 12 receives a signal from the transmitter 20, receiver 12 emits a sound. Using the sound, the arrow can be located.

ARGUMENT

Claims 1-21 are currently pending in this application. In a May 7, 2003 Final Office Action, the Examiner rejected claims 1-10 and 16-21 under 35 U.S.C. § 103(a) as being obvious and unpatentable over United States Patent No. 5,912,864 ("Maurer") in view of United States Patent No. 5,810,685 ("Willner et al."). The Examiner rejected claims 11-15 under 35 U.S.C. § 103(a) as being obvious over Maurer in view of Willner et al. in further view of United States Patent No. 5,468,000 ("Bennett"). The Applicants respectfully traverse the rejection of claims 1-21 under 35 U.S.C. § 103(a).

GROUP I

As an initial matter, the Examiner seemingly dismisses the claim recitation of "at least one timer integrated with the ball for measuring at least one predetermined time period" because, according to the Examiner, the limitation is merely "a recitation of the intended use of the claimed invention." However, the functional language is not an intended use of the claimed invention, but rather a specific limitation on the timer. In fact, section 2173.05(g) of the MPEP explicitly allows the use of functional limitations so long as the functional limitation "fairly conveys to a person of ordinary skill in the pertinent art" what the limitation encompasses. *See generally Rohm and Haas Co. v. Brotech Corp.*, 127 F.3d 1089, 1092 (Fed. Cir. 1997); *ZMI v. Cardiac Resuscitator Corp.*, 844 F.2d 1576, 1578-81 (Fed. Cir. 1988); and *Mannesman Demag Corp. v. Engineered Metal Products, Co.*, 793 F.2d 1279, 1282 (Fed. Cir. 1986) (all interpreting functional limitations in claims).

In this case, it is respectfully submitted that one of ordinary skill in the art would understand the difference between a timer that measures a predetermined time period and a timer that measures a random or arbitrary time period. Thus,

the Examiner's dismissal of the Appelants' previous argument because the functional limitation was a mere intended use was in error.

In the Final Office Action, the Examiner admits that Maurer does not disclose or teach a timer "for measuring at least one predetermined time period" as recited by claims 1, 18, and 21, which are the independent claims of the present application. Rather, the Examiner suggests "the timer of Maurer is capable of performing the stated function." But even assuming Maurer theoretically could, or would be modified as suggested by the Examiner, it would completely defeat the purpose for which Maurer was conceived and developed. In particular, the timer disclosed in Maurer is designed to measure the flight duration of an object. See, for example, Maurer at title, abstract, and various other references in the specification. The duration of flight depends on factors including, for example, the weight of the object, the aerodynamics of the object, the wind resistance, the force and acceleration of the object, the trajectory of the object, the gradient of the ground over which the object is throw, and the like. The duration of flight is based on a number of non-related factors resulting in a counter than must count an indeterminate time period or a non-predetermined amount of time. Thus, if Maurer were modified to count a predetermined amount of time (and the Examiner has shown no motivation or reason for one of ordinary skill in the art to do so), the invention disclosed in Maurer would no longer function because the duration of flight and the measured time would no longer have any correlation. Thus, the applicants respectfully suggest that modifying the timer of Maurer to count a predetermined amount of time would destroy the intended function of Maurer. Thus, Maurer does not render the present invention obvious. *See In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Further, neither Willner et al. nor Bennett cure the defect of Maurer as neither disclose nor teach any counter or timer. Thus, the applicants respectfully submit

that the references of Maurer, Willner et al., and Bennett do not render obvious claims 1-21 of the present invention either alone or in any reasonable combination thereof. Therefore, the applications request the Examiner withdraw the rejection and allow the pending claims.

While the applicants believe the above is sufficient to prove the present claims are allowable over the references, the Examiner in the May 7, 2003 Final Office Action, and the June 2, 2003 Advisory Action failed to address a second reason why the combination of Maurer and Willner et al. does not disclose or suggest the present invention. In particular, claims 1 and 18, as amended in the Jaunary 14, 2003 Amendment, recites a combination of elements including, for example, "the at least one sound generator for producing at least one sound based on the at least one predetermined time period," which is neither disclosed nor suggested by the cited references. In particular, Willner et al. at most discloses a sound generator that produces a sound based on an accelerator and not based on the time period at all. Even if the sound generator of Willner et al. was incorporated into the ball of Maurer, there is no disclosure capable of coordinating the sound generator of Willner et al. with the time of flight measurement of Maurer much less produce a sound generator that is based on a predetermined time period counted by a timer. At most, modifying the Maurer device with the sound generator of Willner et al. would produce an object that measured time of flight and produced sound based on acceleration and/or deceleration of the object. Conversely, the present invent produces "at least one sound based on the at least one predetermined time period." Thus, for this additional reason, amended claim 1 is patentably distinct from Maurer and Willner et al. either alone or in any reasonable combination thereof.

GROUP II

Finally, the Examiner believes Bennett is within the same field of the present invention because they both relate to flying objects. However, the field and problem associated with Bennett is the location of an object after it has landed in an undesired space. Conversely, the field and problem addressed by the present invention is the turning on of a timer when an object comes within a predetermined distance form a target. The applicants respectfully submit that the field and problems are sufficiently different to render the combination of Bennett with Maurer and/or Willner et al. in proper.

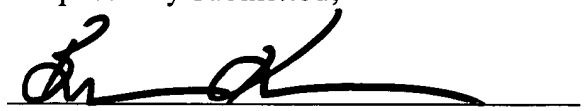
Even if the Examiner maintains Bennett to be properly combinable with Maurer and Willner et al. the Bennett reference does not cure the defects associated with Maurer and Willner et al. noted above. Thus, the applicants respectfully submit that the present invention is allowable over the references either alone or in any reasonable combination thereof.

Request:

Reversal of the Examiner's final rejection of claims 1-21 under 35 U.S.C. § 103(a) is respectfully requested for the above-stated reasons.

Signed this 5 day of September, 2003.

Respectfully submitted,



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APPENDIX

Claims 1-21 involved in this Appeal read as follows:

1. An apparatus, comprising:

a ball;

at least one timer integrated with the ball for measuring at least one predetermined time period;

at least one sound generator integrated with the ball; and

the at least one sound generator for producing at least one sound based on the at least one predetermined time period.

2. The apparatus according to claim 1, wherein the at least one sound generator produces the at least one sound at the end of the at least one predetermined time period.

3. The apparatus according to claim 1, wherein:

the at least one timer is mounted on the surface of the ball.

4. The apparatus according to claim 3, wherein:

the at least one sound generator is mounted on the surface of the ball.

5. The apparatus according to claim 1, comprising a reset.

6. The apparatus according to claim 1, comprising a display mounted on the surface of the ball.

7. The apparatus according to claim 1, comprising:

at least one control panel;

the at least one control panel, comprising:

at least one reset; and

at least one count period select.

8. The apparatus according to claim 7, wherein at least one of the at least control panels has at least one display.

9. The apparatus according to claim 7, wherein the at least one reset is a push button.

10. The apparatus according to claim 9, comprising a cover panel.

11. The apparatus according to claim 1, comprising:

a receiver integrated with the ball; and

at least one remote control capable of sending signals to the receiver.

12. The apparatus according to claim 11, wherein the at least one remote control sends at least a reset signal.

13. The apparatus according to claim 12, wherein the at least one remote control sends at least a count period select signal.

14. The apparatus according to claim 1, comprising:

a receiver integrated with the ball; and

a proximity controller.

15. The apparatus according to claim 14, wherein the proximity controller is capable of sending a signal to the receiver when the ball is within a predetermined distance such that the receiver signal actuates a reset.

16. The apparatus according to claim 1, comprising:
a motion detector integrated with the ball.

17. The apparatus according to claim16, wherein the motion detector detects motion and actuates a reset on a predetermined motion.

18. An apparatus, comprising:
a ball;
means for measuring at least one predetermined time period; and
means for indicating the end of the at least one predetermined time period.

19. The apparatus according to claim 18, comprising:
means for resetting the measuring means.

20. The apparatus according to claim 18, comprising:
means for selecting the at least one predetermined time period.

21. An apparatus, comprising:
a ball having a surface and at least one internal cavity;
at least one timer for measuring at least one predetermined time period; and

the timer integrated with the ball.